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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/743,255	01/05/2001	Ralf Ruther	P00,1929	7812

29177 7590 06/04/2004  
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EXAMINER

JAMAL, ALEXANDER

ART UNIT	PAPER NUMBER
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2643

DATE MAILED: 06/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/783,288

Applicant(s)

LESHNER ET AL.

Examiner

Alexander Jamal

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-5** rejected under 35 U.S.C. 103(a) as being unpatentable over Morgenthaler (6310609), and further in view of Nazanin et al. (5625683).

As per **claim 1**, Morgenthaler discloses a mobile phone comprising a microprocessor (Col 2 lines 48-67), an input with lightable keys (Col 3 lines 35-67) and a display (Fig. 1). The microprocessor has a menu structure with options that are called by the user via the keypad (Col 6 lines 33-67). The keys are enabled to light or flash to indicate to the user the proper button to push as the user navigates through the menu structure of the phone (Fig. 4). The key remains lit until it is pressed. However, Morgenthaler does not specify a memory list with key words that are assigned to an option, with the key words being selectable via the keys.

Nazanin discloses a mobile telephone that comprises a directory of numbers that the user may desire to call (ABSTRACT, Col 3 lines 50-67). He further discloses that the called party's name may be input by the user and associated with the telephone number. This is a memory list and the keywords are the peoples names. In Morgenthaler's

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system, the user would select the keyword (called party's name) from the memory list and then the appropriate keys on the keypad would light up to direct the user to complete the call to the selected person (identified by the keyword). It would have been obvious to one of ordinary skill in the art at the time of this application to implement a phone directory in Morganthaler's system for the purpose of allowing the user to more easily dial a frequently dialed person's number without having to constantly remember that person's number (only the keyword, aka name needs to be selected from the memory list).

As per **claim 2**, the menu structure of Morganthaler's system (including the key words taught by Nazanin) is selectable via the alphanumeric keys and scroll keys (Morganthaler Fig. 1).

As per **claim 3**, in Nazanin (Col 3 lines 50-67) the key words can be freely edited by the user (via the input disclosed by Morganthaler).

As per **claim 4**, Morganthaler discloses that each menu step is displayed by intermittent illumination of the keys (Fig. 4).

As per **claim 5**, Morganthaler and Nazanin specify that their devices are mobile telephones. Additionally, Morganthaler discloses that his invention may be utilized in any wired or wireless communicator that comprises a keypad to direct an internal command sequence (MORGANTHALER: Col 9 lines 15-25). However, they do specify that the sets may be a DECT or GSM handset.

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It would have been obvious to one of ordinary skill in the art at the time of this application that the communications device could have been a DECT or GSM handset (or any other brand or standard of telecommunications device) for the purpose of allowing the invention to be used by users of all telecommunications terminals.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Jamal whose telephone number is 703-305-3433. The examiner can normally be reached on M-F 8AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis A Kuntz can be reached on 703-305-4708. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9315 for After Final communications.

AJ  
May 26, 2004

  
CURTIS KUNTZ  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600